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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/586,433

11/26/2008

Matthias Prinz

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EXAMINER

MORRISON, THOMAS A

ART UNIT

PAPER NUMBER

3653

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/586,433	<b>Applicant(s)</b> PRINZ, MATTHIAS	
	<b>Examiner</b> THOMAS A. MORRISON	<b>Art Unit</b> 3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____.  | 6) <input type="checkbox"/> Other: ____.                          |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Each of the claims 1-11 fails to clearly recite specific method steps. For example, claim 1 merely provides a recitation with conditional limitations that need **not** ever occur. As one working example, if no jam occurs in the invention set forth in claim 1, none of the recited functions in claim 1 is required to be performed. In other words, the flap is not required to be actuated and the printing material is not required to be transported out of the transport path if no jam occurs. Claims 1-11 need to be rewritten to positively recite method steps that are performed in the method.

Claims 9-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, MPEP, section 2173.05(p) states,

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"A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. 112, second paragraph." Id. Claim 1 recites "a method for transporting printing material through a printing machine". Then, claims 9-11, which depend from claim 1, recite structural elements that further define an apparatus, rather than setting forth method steps. Since claims 9-11 claim both an apparatus and the method steps of using the apparatus, these claims are indefinite. Applicant needs to positively set forth method steps in claims 9-11.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 9-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. In particular, claims 9-11 are directed to neither a "process" nor a "machine," but rather embrace or overlap two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. See, MPEP, section 2173.05(p). More specifically, claims 9-11 recite both a process and a machine.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-8, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,867,431 (Hosking et al.).

Regarding claim 1, Figs. 1-3 disclose a method for transporting printing material (col. 1, line 9) through a printing machine, characterized in that, in the event of an occurrence of a paper jam in the transport path (Fig.1), a flap (25) on the transport path (Fig. 1) is actuated, and a sheet of printing material (col. 1, line 9) is transported along the flap (25) out of the transport path (Fig. 1). See, e.g., col. 2, lines 11-14 and col. 4, line 61 to col. 5, line 3. Alternatively, it is noted that claim 1 recites “conditional limitations” that need not ever occur (i.e., claim 1 recites “in the event of any occurrence of a paper jam”). In other words, if no jam occurs, there is no requirement for the flap to be actuated at all, and there is no requirement for the printing material to be transported out of the transport path.

Regarding claim 2, Figs. 1-3 disclose that the sheet of printing material (col. 1, line 9) is transported by the transport rollers (22 and 31) at the flap (25) out of the transport path (Fig. 1) into a container (34). See, e.g., col. 2, lines 11-14 and col. 4, line 61 to col. 5, line 3.

Regarding claim 3, Figs. 1-3 disclose that the flap (25) is actuated by a solenoid.

Regarding claim 4, Figs. 1-3 disclose that the flap (25) is activated after removal of the paper jam and assumes its original, closed position. What if the jam is never removed?

Regarding claim 5, as best understood, col. 4, line 45 to col. 5 line 3 discloses that the drives which are located downstream of the paper jam are continued to be driven, so that the sheets of printing material (col. 1, line 9) downstream of the paper jam are continued to be transported, and that the drives located upstream of the paper jam are stopped, so that sheets of printing material (col. 1, line 9) which are located upstream of the paper jam are no longer transported.

Regarding claim 6, as best understood, Figs. 1-3 disclose that simplex-printed or duplex-printed finished sheets of printing material (col. 1, line 9) downstream of the paper jam are transported to a tray (34) of the printing machine and that unfinished sheets of printing material (col. 1, line 9) downstream of the paper jam are transported to the container (34). In particular, any sheets at or downstream of the jam will be transported to the container/tray (34).

Regarding claim 7, as best understood, col. 4, lines 1-14 and col. 4, line 61 to col. 5, line 3 disclose that a paper jam is detected by at least one sensor arrangement on the transport path (Fig. 1) and, as a result, the flap (25) is opened.

Regarding claim 8, as best understood, Figs. 1-3 disclose that the flap (25) is opened, sheets of printing material (col. 1, line 9) are moved out of the region of the

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switches (col. 4, lines 1-14), the flap (25) is closed and the switches (col. 1, lines 1-14) are reset in such a manner that the sheets of printing material (col. 1, line 9) are transported to the exits (33) of the printing machine.

***Allowable Subject Matter***

4. The fact that claims 9-11 have not been rejected in view of prior art is not an indication that such claims include allowable subject matter, particularly in view of the rejections of these claims under 35 USC 101 and 35 USC 112 outlined above. For example, claims 9-11 are too indefinite to make a determination as to allowability of these claims.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to THOMAS A. MORRISON whose telephone number is (571)272-7221. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on (571) 272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patrick H. Mackey/  
Supervisory Patent Examiner, Art  
Unit 3653

3/29/2009